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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,458	02/28/2002	Haixing Wan	009679-054	4976

7590

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/084,458	Applicant(s) WAN, HAIXING	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 with respect to the elected and applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 02. 6) ☐ Other: _____

This is in response to the Election filed on 14 April 2003.

I. Applicant's election with traverse of the invention of Group I, claims 1-12 in Paper No. 05 is acknowledged. The traversal is on the ground(s) that (1) a search for the inventions has some parts being overlapped only and (2) an additional and complete search for the non-elected invention is not burdensome. This is not found persuasive because an additional and complete search for the non-elected invention is burdensome.

The requirement is still deemed proper and is therefore made FINAL.

II. Applicant's election of species with traverse being acknowledged. The traversal is on the ground that there is not burdensome. This is not found persuasive because an additional and complete search for all of the non-elected species is burdensome.

III. The elected species on the record has been considered and searched. The consideration and searched are extended to the applied species. Other non-elected species have not been considered, searched or examined until all of the elected and applied species are overcome.

IV. (1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process (In re Swinehart, 169 USPQ 226). (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (In re Swinehart, 169 USPQ 228). Therefore, one should be carefully looked into it

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for his own benefit. Please also see *In re Schreiber*, 44 USPQ2d 1432 since it is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in *In re Best*, 195 USPQ 430; *Ex parte Maizel*, 27 USPQ2d 1662 or *Ex parte Phillip*, 28 USPQ2d 1302. The language "form a liquid containing...at about room temperature" is considered as the functional, characteristic, chemical and physical property of a material and process.

(2) Within the authority of the Office being granted by the authority in the court of law, applicant is required to show or provide an evidence to the contrary to the applied material and process from the applied reference for the claimed property of the material and process as claimed for its patentability in accordance with the authority stated in *In re Swinehart*, 169 USPQ 228. It is should be noted that an argument alone (1) would be taken a place of an objective evidence as a matter of law (2) has and (3) is given a little to no value.

V. Applicant's prior art submission filed on 18 June 2002 has been considered.

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuykendall et al (6,534,253).

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Kuykendall et al disclose, teach and suggest a method for making or obtaining a ferric (Fe^{+++} , Fe III or iron III) 1,3-proylenediaminetetraacetate or its adjacent homologue, ferric (Fe^{+++} , Fe III or iron III) ethylenediaminetetraacetate, comprising the step of (1) combining a ferrous (Fe^{++} or Fe II or iron II) salt selected from ferrous bromide with a alkylenepolyaminopolycarboxylic acid selected from 1,3-propylenediaminetetraacetic acid or its adjacent homologue, ethylenediaminetetraacetic acid to make or obtain up to 100% of ferrous 1,3-propylenediaminetetraacetate or its adjacent homologue, ferrous ethylenediaminetetraacetic acid and (2) and oxidizing the ferrous 1,3-propylenediaminetetraacetate to make or obtain ferric 1,3-propylenediaminetetraacetate as claimed or its adjacent homologue, ferric ethylenediaminetetraacetate. Please see the whole disclosure of the applied reference, especially at col.4:47-52, 5:43-45, 7:5 and 13-17, 8:65 to 9:25, 10:7-9 and Examples. Since Kuykendall et al disclose, teach and suggest the requisite processing steps and the requisite chemicals for use in the processing steps as the main and essential embodiments of the claims, the elected invention of claims 1-12 with respect to the elected and applied species are found to be rendered prima facie obvious by Kuykendall et al.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number of the examiner is 703-746-7172..

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
29 April 2003

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le